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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,270	08/07/2001	Kenji Takahashi	MM4461	4894

7590 07/25/2003

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New York, NY 10020-1182

EXAMINER
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PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 07/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/924,270

Applicant(s)

TAKAHASHI ET AL. 

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

#### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 6/24/03 and 5/27/03 have been entered.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1,2,3,4,6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection. As now claimed the phrase describing the side by side in parallel arrangement is not found in the specification as originally filed.

✓✓ dig to phrase no support in spec

The following is a quotation of the second paragraph of 35 U.S.C. 112:

4. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1-4,6-7 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter, which applicant(s) regard as their invention.

As amended, the independent claim now recites:

a) in claim 1, lines 15-17 that one of the plurality of projections in addition to another projection – provided on the lens holder are disposed in a side by side arrangement parallel with the recording surface.

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The following problem arises:

a) as depicted in figure 13 the plurality of projects (39 a,b) which are provided on the suspension holder and the "another" projection – either 38a or 38b are not in a side-by-side arrangement. ✓

b) additionally, with respect to figure 5, the plurality of projections in the frame (37a, 37b) is not provided in a side-by-side arrangement with one of the second projections. This is compounded by the lack of having first projections having the elastic supports fixed thereto. The elastic supports are not fixed to any such projections. It is not clear what the side-by-side language is attempting to define. Further clarification is respectfully requested. It is noted that there are projections on opposite sides of the lens holder. ✓

As an aside, there are no figures depicting the fixed attachment of the elastic supports to the first projections.

As far as the examiner interprets the claims and recite positive limitations, the following rejections are made.

As amended, claim 1 is drawn to fig. 13, one embodiment, while claims 2-7 are drawn to fig. 5 another embodiment. No restriction is given, e.g. different species since the examiner concludes these to be obvious variants over each other.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 2, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by either Masunaga, or Tomita ('661), or Tomiyama et al

With respect to the independent claim<sup>1</sup>, the above documents depict a protrusion/projection at various locations:

✓  
a) Masunaga, the lens is element 147, lens holder – element 148, suspension holder 142 (a), frame 30, plurality of elastic supports 153, and actuator – not shown. With respect to the plurality of projections and the "another projection" applicants' attention is drawn to the description starting at col. 7 with respect to the figures wherein the "another" projection is either of the 30a or 153<sup>b</sup> projections found on the lens holder 148 while there is a plurality of projections on the suspension holder – 153a.

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Furthermore, with respect to claim 2, the elastic supports are fixed to the first projections, either the top or bottom portion of element 153b – see figure 9, while the second projection is the remaining projection, i.e., the bottom or top portion of the projection 153b.

b). Tomita ('661) see fig. 9-12 with respect to the projections depicted thereon.

As far as the examiner interprets the claim language, the plurality of projections are noted – the wings shown in figure 9 are the “another” projection of new claim 1.

With respect to claim 2, the first projections are either the top or bottom wings (21” in figure 7, 30 in figure 8) depicted in figure 9, while the bottom projections are the second projections of claim 2.

With respect to Tomita et al – again see figure 1, wherein the wing structure is depicted as part of the lens holder. Again, the upper wings are interpreted as the second projections and the wherein clause follows accordingly.

c) Tomiyama et al – see figures 2 and 4. The projections are 2b, 2c, 2d, 2e attached to the lens holder, while projects 6a,6b,6c,and 6d are the projections attached to the suspension holder.

With respect to claim 1, the first projections – either those attached to the suspension holder and the “another” projection is any one of 2b,c,d,e.

With respect to claim 2, the first projections any of 2b,c,d,e and the second projections any of the remaining projections 2b,c,d,e.

As far as the examiner interprets applicants' termed projections, the above documents meet this limitation. The remaining claimed elements are self-evident.

The limitations of claim 4 follow, i. e., a total of four projections. Furthermore, as best as examiner can interpret from the above documents, the limitations of claim 7 follow, the outer surfaces of these projections project from the lens holder approximately the same distance.

11. Claim 3 are rejected under 35 U.S.C. 103(a) as obvious over the cited documents above with respect to claim 1 further considered with JP 62-031036.

With respect to claim 3, the position defined is considered evident in the JP document.

The examiner interprets the limitations of claim 3 as a relocation of the projections, i.e., a relocation of parts, and obvious to one of ordinary skill in the art, since the function would still be retained.

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The positioning of the projections would be a matter of choice by the manufacturer of the lens holder, as part of any molding technique. No unexpected results/or criticality is seen to occur from relocating these projections.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Wada et al.

Selection of elastic elements as defined in claim 6 is taught by the Wada et al reference.

Substituting such for the elastic members in any of the above noted prior art systems are merely a selection of equivalents with no unexpected results occurring from such a substitution.

13. The indicated allowability of claim 5 is withdrawn in view of the newly discovered reference(s) to Tomiyama et al. Rejections based on the newly cited reference(s) follows.

14. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Tomiyama et al.

Applicants' attention is drawn to figures 1, 2 and four and the description thereof.

As noted, in figure 2, the examiner interprets the first projections as 2b,d and the second projections as 2c,e. The distance limitations are considered inherently present because the second projections are closer to the recording surface than the first projections 2b,d. The examiner interprets the last wherein phrase as met by this configuration of projections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

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Aristotelis M Psitos  
Primary Examiner  
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A handwritten signature in black ink, appearing to read 'A. Psitos', written over the printed name and title.

AMP  
July 23, 2003